

REMARKS

Claims 1-9 were originally filed. By Office Action mailed September 8, 2004, Claims 5 and 7-9 stood withdrawn as being elected to non-elected subject matter. In the Response to the Office Action mailed April 23, 2004, Claims 1-4 and 6 were cancelled in favor of newly presented Claims 10-35. Arguments with respect to the patentability of new Claims 10-35 were presented in the Response. In the Office Action mailed September 8, 2004, the Examiner contended that the Response was non-responsive and that new Claims 10-35 were therefore withdrawn from consideration as being directed to non-elected subject matter. In the instant Response, Claims 10-35 are cancelled to be pursued in a separate divisional application. Newly added Claims 36-40 are directed to subject matter of elected Group II (original Claims 1-4 and 6). Claims 5 and 7-9 continue to stand withdrawn as being directed to non-elected subject matter. New Claims 36-40 are fully supported by the specification as originally filed and do not constitute new matter. Accordingly, Applicants respectfully request entry of the above amendments to the claims and reconsideration of the claimed subject matter in light of the following remarks, which are directed to the outstanding rejections of the specification and Claims 1-4 and 6, as set forth in the Office Action mailed December 23, 2003.

Rejection of Claims 1-4 and 6 under 35 U.S.C. 102(b):

The Examiner rejected Claims 1-4 and 6 under 35 U.S.C. 102(b) as being anticipated by the teachings of PCT Published Patent Application, WO 92/11046 ("Ahmad"). In particular, the Examiner contends that Ahmad discloses a dialysate solution for use in treating patients from kidney failure via dialysis treatment.

Claims 1-4 and 6 are cancelled herein, thereby rendering moot this rejection with respect to this claim. Applicants respectfully traverse this rejection with respect to new Claims 36-40 in light of the following remarks.

In order to reject Claims 36-40 under 35 U.S.C. 102(b) in view of Ahmad for anticipation, the Examiner would have to demonstrate that each and every claim limitation is contained in the disclosure of Ahmad. See *Scripps Clinic & Research Foundation v. Genentech*,

Inc., 18 USPQ2nd 1001, 1010 (Fed Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986); see also MPEP § 2131 (August 2001). For the following reasons, Applicants respectfully submit that the disclosure of Ahmad fails to disclose all the limitations of the invention as set forth in new Claims 36-40 and therefore fails to anticipate these claims under 35 U.S.C. 102(b).

The disclosure of Ahmad is directed to dialysate compositions that, upon mixing with water, comprise the following:

- from about 130 to about 150 mEq/L of sodium ion;
- from about 0 to about 4.0 mEq/L of potassium ion;
- from about 2.0 to about 3.5 mEq/L of calcium ion;
- from about 0 to about 1.5 mEq/L of magnesium ion;
- from about 25 to about 45 mEq/L of bicarbonate ion, acetate, lactate or combinations thereof;
- from about 0 to about 2.0% glucose;
- from about 90 to about 120 mEq/L of chloride ion;
- and
- from about 2 to about 12 mEq/L of citric acid.

Although Ahmad does disclose the use of above-described dialysate composition in hemodialysis of a patient with kidney failure, Ahmad fails to disclose the actual dialysate compositions utilized in new Claims 36-40. The dialysate composition of new Claims 35-40 **requires** the presence of magnesium. In contrast, the dialysate compositions disclosed in Ahmad optionally require magnesium (see, e.g., Claim 4 of Ahmad which states that magnesium is present at a concentration "from about 0 to about 1.5 mEq/L of magnesium ion"). The presence of magnesium and calcium in the claimed dialysate composition is essential in that it maintains the amount of magnesium and calcium present in the patient's blood at physiologically acceptable levels during the hemodialysis. Without the presence of magnesium and calcium in the dialysate composition, the citrate in the dialysate composition would bind to the free calcium and magnesium present in the patient's blood, which, in turn, would lower the amount of free calcium and magnesium in the patient's blood to potentially dangerous physiological levels.

Thus, the presence of magnesium and calcium in the claimed dialysate composition is essential in order to prevent physiological events that may occur as a result of low levels of magnesium and calcium in the blood of the patient undergoing hemodialysis.

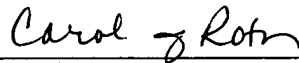
In addition, Ahmad does not disclose the claimed dialysate compositions because the dialysate compositions disclosed in Ahmad can **not** contain citrate at a concentration level *greater* than 12 mEq/L.

In view of the fact that Ahmad fails to disclose the claimed dialysate compositions used in new Claims 36-40, Applicants respectfully submit that the teachings of Ahmad fail to anticipate new Claims 36-40. Accordingly, Applicants respectfully submit that new Claims 36-40 are patentable under 35 U.S.C. 102(b) in light of the teachings of Ahmad. Favorable consideration of Claims 36-40 and early allowance thereof is therefore respectfully requested.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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